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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,732

06/09/2005

James Nabors

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26748 7590 08/23/2007
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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

08/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,732

Applicant(s)

NABORS ET AL.

Examiner

Alton N. Pryor

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-16,18-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-16 and 18-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election requirement made on 5/16/07 was improper since Examiner Clardy examined all the claims without requiring an election of invention in office action dated 10/16/06. For this reason, the Election requirement dated 5/16/07 is withdrawn.

Applicant's arguments filed 2/16/07 have been fully considered but they are not persuasive. See argument below. Examiner's rejection is restated below. Claims 26-40 are now included in Examiner's Clardy rejection of record.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4-16,18-25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Penner et al (US 6235682) and Feucht et al (US 6365550). Claims 26-40 are added to this rejection.

Penner et al teach compositions comprising a herbicide such as an acetanilide or acetamide herbicide, among others (acethochlor, alachlor, flufenacet, metolachlor; columns 6 and 11, and Table 1) and an oil based adjuvant which enhances the herbicidal activity, such as a free fatty acid (column 5, lines 53-64). The compositions contain an organosilicon containing adjuvant which serves to reduce the foliar retention of the composition so that it does not adhere to desirable crop plants, but controls weeds beneath them.

Art Unit: 1616

Feucht et al teach herbicidal compositions comprising flufenacet as the herbicidal agent in combination with glyphosate or glufosinate (abstract) in combination with conventional adjuvants including organic solvents and oil based adjuvants such as xylene, toluene, or alkylnaphthalenes, aliphatic hydrocarbons such as cyclohexane or paraffins, mineral oil fractions, mineral and vegetable oils, etc. (column 4, lines 21-33).

Thus it would have been prima facie obvious to one having ordinary skill in the art to use the customary oil based adjuvants of Feucht et al with the active agents and fatty acid components of Penner et al in order to obtain the beneficial characteristics of the Penner compositions.

Response to Applicants' Argument

Applicants argue that instant invention does not require silicon-based material as repellent adjuvants whereas Penner's invention requires silicon-based materials as repellents. Penner does not recite the use of specific fatty acids as recited in instant claims. Feuchet's reference is directed to synergy imparted by the herbicide combination without regard to the solvents used. Applicant further argues that instant invention declares synergistic or unobvious results on page 21 of the specification.

Examiner argues that instant claims employ "comprising" language which allows for the inclusion of additional ingredients such as the silicon-based materials. In a 103(a) rejection the prior art is required to specifically teach a claimed invention but must rather suggest the claimed invention. Therefore, since Penner broadly teaches fatty acids, Penner encompasses the teaching of Applicants' specific fatty acids. Feucht broadly teaches the fatty acid and hydrocarbons of the instant claims and therefore

Art Unit: 1616

Feuchet's teaching makes the instant fatty acids and hydrocarbons obvious regardless of whether or not they impart activity to his composition. With respect to Applicants' unexpected results for their invention shown on page 21 of the specification, the results are unobvious but broader than the scope of the claims. Note, Applicants' result are supportive of a herbicidal composition comprising S-metolachlor plus benoxacor plus Isopar (need actual name), stearic acid or stearyl alcohol. A claim similar in scope to results listed in Tables 1 and 2 on pages 20 and 21 may be allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

Art Unit: 1616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Alton Pryor', with a stylized flourish at the end.

Alton Pryor
Primary Examiner
AU 1616